O/0958/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003972275
BY PT KINO INDONESIA TBK
TO REGISTER:

ELLIPS

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 445790
BY ELLIPSIS BRANDS LIMITED

BACKGROUND AND PLEADINGS

1. On 26 October 2023, PT Kino Indonesia Tbk ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 10 November 2023 in respect of the following goods:

> **Class 3:** *Shampoo; hair conditioners; hair oils; hair care lotions [for cosmetic use]; oils for hair conditioning; hair tonics; hair serums; dry shampoos; beauty masks; cosmetics; hair masks; hair sprays; perfumery; hair mists; hair care preparations.*

2. On 12 February 2024, the application was opposed by ELLIPSIS BRANDS LIMITED ("the opponent") based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under both Sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks and all of the goods covered by the same, as shown below:

UK00917800053 ("the first earlier mark") ELLIPSIS Filing date: 09 February 2018 Registration date: 25 May 2018 **Class 3:** *Cosmetics.*
UK00003374453 ("the second earlier mark") Ellipsis Labs Filing date: 11 February 2019 Registration date: 03 May 2019 **Class 3:** *Cosmetics.*

4. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. Only the opponent’s first earlier mark had been registered for five years or more at the filing date of the contested mark, and, as such, it is subject to the use conditions under Section 6A of the Act. However, as the second earlier mark is less than five years old, it is not subject to the use provisions and the opponent may, therefore, proceed to rely upon all the goods identified in its notice of opposition without having to show that it has genuinely used the mark.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the goods are identical or similar, all being cosmetics and/or products designed for personal care and skincare, and the marks are visually and aurally similar.

6. Under Section 5(3), the opponent claims that its earlier marks enjoy a reputation in relation to all of the registered goods and reiterates the claim that customers will see the contested mark as an extension of the opponent's marks confusing the origin of the goods, leading to the applicant taking unfair advantage of, or causing detriment to, the reputation and distinctive character of the opponent's marks.

7. Under Section 5(4)(a), the opponent relies upon the unregistered sign ‘ELLIPSIS’ which it is said has been used throughout the UK since 2018 in relation to the following goods and services: *cosmetics; cosmetic preparations; skincare cosmetics; beauty care cosmetics; moisturisers; serums; face and skin oils; makeup primer; retail services in relation to cosmetics and toiletries; online retail services relating to cosmetics and toiletries; marketing research in the fields of cosmetics, perfumery and beauty products; cosmetic product design and development.*

8. The opponent claims that the ‘ELLIPSIS’ brand has been used in the UK since 2018, that ‘ELLIPSIS’ is the opponent's company name, and that it is also used as a brand for a range of cosmetics and related services. Further, the opponent states that it has generated a substantial reputation and goodwill in respect of the business conducted under the mark ‘ELLIPSIS’ and that “*given that the marks are similar, and the overlap of goods and similarity of services, it is inevitable that the relevant public would be*

misled into believing that the goods provided by the applicant are either those of the opponent or authorised by or associated with the opponent when this is not the case". As a result, the opponent is likely to suffer damage, and the application should be refused under Section 5(4)(a).

9. The applicant filed a defence and counterstatement, denying the opponent's claims and putting it to proof of use of the first earlier mark as well as to proof of reputation and goodwill. In addition, the applicant claims that even if the opponent were able to demonstrate genuine use of the first earlier mark, reputation and goodwill, the opposition should fail under all grounds because the marks are dissimilar, and the nature of the goods is such that the average consumer would be able to distinguish between the marks. It states:

> *"ELLIPS is coined word with no ordinary meaning in English. It is not commonly or habitually used as a contraction of or substitution for the word ELLIPSIS. As such, the Applicant contends that it is visually, conceptually, and phonetically different enough from either ELLIPSIS or Ellipsis Brands, and different enough at the overall level on a global assessment, that the average consumer of cosmetic products is unlikely to confuse the two.*
>
> *Moreover, as the cosmetics sector has grown in popularity in the era of social media and "influencer" and celebrity endorsements, there has been a huge proliferation in cosmetics brands. It is contended that the average British customer for cosmetics has a strong and very personal connection to their cosmetics brand of choice, and inasmuch as cosmetics are applied to the skin, hair or body of the customer, this notional customer is also highly cautious and savvy when trying out a new brand. In light of this, the Applicant contends that they will bring a high degree of care and attention to any brand comparison.*
>
> *Given the dissimilarity of the marks under comparison, as well as the nature of the class 03 goods and the average customer's personal attachment to such goods and their high degree of savvy in buying decisions, the Applicant denies - assuming the Opponent can overcome the evidential hurdles - that there is a reasonable likelihood of confusion within the meaning of section 5(2)(b), a*

reasonable likelihood of unfair advantage or damage or dilution within the meaning of section 5(3), or a likelihood of misrepresentation in the marketplace and/or damage to goodwill within the meaning of section 5(4)(a).”

10. The opponent is represented by Charles Russell Speechlys LLP, and the applicant is represented by Harrison IP Limited.

11. Both parties filed evidence in chief, with the opponent also filing evidence in reply. Neither party requested a hearing, but they both filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

MY APPROACH

13. Although the opponent relies on one earlier mark that is subject to proof of use, that mark is not materially stronger than the other mark that is not subject to proof of use. Without pre-empting the assessment of the overall impression of the marks, the only difference between the first and the second earlier marks is the addition, in the second earlier mark, of the word ‘Labs’ which, in the context of the cosmetics goods concerned, will be seen as a descriptive element referring to the place where the goods are produced. Hence, I will disregard the first earlier mark (and the proof of use to which that mark is subject) for the purpose of Section 5(2)(b), and I will return to it only if necessary.

EVIDENCE

14. The opponent's evidence came in the form of two witness statements from Freddy Furber dated 16 July 2024 and 1 October 2024. Mr Furber's first witness statement is accompanied by six exhibits (being those labelled FF01-FF06), whereas his second witness statement is accompanied by one exhibit, being that labelled FF07. Mr Furber is the CEO of the opponent's company, a position he has held since 2013. His evidence in chief is aimed at showing use of the earlier marks by the opponent as well addressing the applicant's claim about brand loyalty in the cosmetic sector; his evidence in reply is aimed at showing that not all of the opponent's products are sold through its website, with some of the products being sold on Amazon.

15. The applicant's evidence came in the form of a witness statement from Mark Smith. Mr Smith is a solicitor working for Harrison IP Limited, the applicant's representative in these proceedings; his evidence is dated 19 August 2024 and is accompanied by three exhibits, being those labelled MS1-MS3. Mr Smith's evidence is only a vehicle for introducing copies of screenshots from the opponent's website and from Amazon, the latter showing the applicant's hair products available for sale, though it misses any narrative which might shed light on the relevance of this evidence for the purpose of these proceedings.

16. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) …

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

20. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

> may think that the responsibility for those goods lies with the same undertaking."

22. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited,* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

23. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

24. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

25. The competing goods are as follows:

The applicant's goods	The opponent's goods
Class 3: *Shampoo; hair conditioners; hair oils; hair care lotions [for cosmetic use]; oils for hair conditioning; hair tonics; hair serums; dry shampoos; beauty masks; cosmetics; hair masks; hair sprays; perfumery; hair mists; hair care preparations.*	**Class 3:** *Cosmetics*

26. When it filed its defence, the applicant did not deny the opponent's claim that the competing goods are identical or similar. It only stated that given the nature of the goods concerned, which involves a high level of customer loyalty and a high degree of attention in selecting the goods, the average consumer is unlikely to be confused.

27. However, the arguments about customer loyalty and degree of attention are not relevant to the assessment of the similarity of the goods which must be carried out based on the criteria set out in *Canon.* In addition, in *SKYCLUB* (BL-O/044/21), Professor Phillip Johnson, sitting as the Appointed Person, stated that the principle that where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)) is applicable in trade mark opposition proceedings. Hence, in this case, the applicant's failure to deal with the identity/similarity of the goods means that the opponent's claim as to their identity and/or similarity is admitted.

28. Having said that, the opponent did not say which goods it considers to be identical and which goods it considers to be similar; nor did it say, for the goods which are not identical, to what degree it considers them to be similar. Consequently, I will carry out my assessment bearing in mind that there is an admission of, at least, a low level of similarity.

29. The term *Cosmetics* is identically contained in both specifications. These goods are **self-evidently identical.**

30. The applied-for term *hair care lotions [for cosmetic use]* means that the products have some cosmetic effects. The dictionary definition of cosmetics is as follows: *"substances that you put on your face or body that are intended to improve your appearance".* Based on the words in brackets, *hair care lotions [for cosmetic use]* are cosmetics because they are substances for use on the hair that are intended to improve the user's appearance. These goods are **identical.** The same finding of identity applies to the following goods in the contested specification: *Shampoo; hair conditioners; hair oils; oils for hair conditioning; hair tonics; hair serums; dry shampoos; beauty masks; hair masks; hair sprays; hair care preparations*, because these goods might contain substances that make them suitable for cosmetics use, i.e. for the purpose of improving the user's appearance. These goods are **identical.**[1]

31. Lastly, whilst *perfumery* and *hair mists* (the latter being a lightweight, water-based perfume specifically designed for use on hair) are not cosmetics, *per se*, they are used together with the opponent's cosmetics as part of a person's beauty regime. This creates some similarity in purpose and use, although I accept that they have a different nature and method of use and are not in competition. The goods, however, target the same users, are likely to be sold in close proximity to each other and are offered by the same or economically linked undertakings. I consider these goods to be **similar to a medium degree.**

Average consumer

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

[1] In its submissions in lieu the applicant seems to admit identity between these goods as it states that "it is conceded that "cosmetics" subsume the various hair products sought to be registered…"

> “60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33. The average consumer of the goods at issue will be a member of general public or a professional user (such as a beautician or a hairdresser). Given that all the goods at issue are for use on the body or hair, the purchaser is likely to consider at least what the ingredients are and whether the goods are suitable for their particular purpose. Accordingly, the level of attention paid will be medium for everyday goods bought by members of the public and slightly higher than medium, for professional purchasers.

34. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalents. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> “.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for mark	**The opponent's earlier mark**
ELLIPS	Ellipsis Labs

Overall impression

37. Both marks are word-only marks. The applied-for mark consists of the word "ELLIPS" in which the overall impression resides.

38. The opponent's mark consists of the words 'Ellipsis' and 'Labs'. Whilst I have submissions from the parties as to the similarity of the marks, neither of them addressed me on the meaning of the word 'Labs' and the weight that should be given to that element. Cambridge online dictionary indicates that 'Labs' is the plural of 'Lab' and that the word 'Lab' is short for 'laboratory' which means *"a room or building with scientific equipment for doing scientific tests or for teaching science, or a place where chemicals or medicines are produced".* In the context of the earlier cosmetics, I consider that the word 'Labs' will be seen as descriptive or allusive or laudatory because it will be understood as referring to the fact that the products are safe and of good quality having been developed or tested in laboratories. Hence, I consider that the dominant and distinctive element of the opponent's earlier mark is the word 'Ellipsis' and that the word 'Labs' will play a lesser role in the overall impression as it will be viewed as an indication that the goods are made or tested in laboratories.

Visual similarity

39. Visually, the marks share the first six letter letters ‘ELLIPS’ presented in the same order. This sits at the beginning of the opponent’s mark and is the totality of the applied-for mark.

40. The marks differ in the presence of the two letters ‘IS’ after the letters ‘ELLIPS’ and the word ‘LABS’ both of which are present in the opponent’s earlier mark and have no counterpart in the applicant’s mark. While these differences must be acknowledged, they do not have a striking effect. I say this because these differences are placed at the end of the mark (where customers’ attention is less focused); in addition, the fact that the extra letter ‘I’ being just a vertical line does not add much length to shared word ‘ELLIPS’ and that the additional letter ‘S’ at the end of the word ‘Ellipsis’ is identical to (and reproduces) the end of the word ‘ELLIPS’ make these difference less noticeable. Furthermore, as both marks are word only marks, they can be presented in the same upper-case letters or in title case. Taking all of this into account and also bearing in mind that consumers tend to focus on beginnings of marks (being where the point of identity lies), I find that the element ‘ELLIPS’ and ‘Ellipsis’ are visually similar to a high degree. Lastly, the impact of the word ‘Labs’ at the end of the opponent’s earlier mark is limited due to its positioning and descriptive nature. Overall, I consider the competing marks to be visually similar to a medium to high degree.

Aural similarity

41. Aurally, the verbal elements ‘ELLIPSIS’ in the opponent’s mark will be pronounced as three syllables, i.e. EL-LIP-SIS, whereas the verbal element ‘ELLIPS’ in the applied-for mark will be pronounced as two syllables, i.e. ‘EL-LIPS’. These elements of the marks are aurally similar to a high degree. Notwithstanding its descriptive/laudatory/allusive meaning, I find that the word ‘LABS’ in the opponent’s mark will be pronounced; in this connection I bear in mind the comments of Mr Phillip Harris, sitting as the Appointed Person, in the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein he stated that

descriptiveness of an element does not render it aurally invisible. Overall, I consider the competing marks to be aurally similar to a medium to high degree.

Conceptual similarity

42. Conceptually, the applicant contends that 'ELLIPS' is a coined word with no ordinary meaning in English and that it is not commonly or habitually used as a contraction of, or substitution for, the word 'ELLIPSIS'. The opponent states that 'ELLIPS' and 'ELLIPSIS' are visually and phonetically highly similar.

43. I agree that the word 'ELLIPSIS' has a dictionary meaning being that of an "*omission of parts of a word or sentence"* or that of "*a sequence of three dots (…) indicating an omission in text",* and that the word 'ELLIPS' does not. Whilst there is a conceptual difference between the two words, insofar has one has a meaning and the other does not, the word 'ELLIPS' is sufficiently close to the word 'ELLIPSIS' to evoke it because the average consumer tends to break down a verbal sign into words known to them[2] - this somewhat counteracts the conceptual difference between the marks. Lastly, the word 'Labs' in the earlier mark being descriptive, allusive or laudatory does not introduce any distinctive conceptual difference between the marks.

Distinctive character of the earlier mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

[2] See *Vitakraft-Werke Wührmann & Sohn GmbH & Co KG v OHIM*, Case T-356/02, paragraph 51

108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

45. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

46. The earlier mark consists of the words 'Ellipsis Labs'. As it will be recalled, I have concluded that the word 'Ellipsis' is the dominant and distinctive element of the earlier mark because the word 'Labs' is descriptive or laudatory or allusive. Since the word 'Ellipsis' is not meaningful in relation to the registered *cosmetics* (i.e. it is neither descriptive nor allusive), it has a normal (medium) degree of distinctiveness. This is the inherent position. In this connection, I have not overlooked Mr Furber's evidence that the word "*ellipsis is used as a replacement for words in a sentence*", that the name was chosen as a brand because it reflected the concept of a 'a collection of brands' and aligned with the opponent's brand ethos and its distinctive brand creation strategy. He stated: *"Ellipsis creates brands that 'speak for themselves' and require few words without lengthy descriptions to describe them."* However, the average consumer is unlikely to understand the message that 'ELLIPSIS' is an umbrella brand under which other brands are developed and marketed; I say this because the consumer will perceive the earlier mark as a single brand name, without knowing that the opponent

owns other brands or use the name as an umbrella brand. The average consumer is also unlikely to be aware of the details of the opponent's brand creation strategy, any of the reasons why the mark was chosen, or the opponent's wider brand ethos as it is impossible to appreciate these facts when simply encountering the mark in the normal way.

47. I will now turn to consider whether the evidence filed by the opponent is sufficient to establish that the earlier mark has acquired an enhanced degree of distinctiveness.

48. Mr Furber says that the opponent has used 'Ellipsis' continuously since 2018, as the name of its company – this was changed to 'Ellipsis Brands Limited' on 31 May 2018. As the opponent's company name, 'Ellipsis' appears prominently on the company's paperwork, purchase orders, invoices and communications. However, this is not use in relation to the registered goods.

49. The opponent's domain name is https://ellipsisbrands.com/ and the opponent also uses 'Ellipsis' as a cosmetic brand name. Mr Furber says that 'Ellipsis' *"is used similarly to L'Oreal as it describes the group of brands, as well as the opponent's product and brand"* and it is *"cross- functional and represents more than just simply being "the name of the company".*

50. The opponent launched the 'Ellipsis Labs' cosmetics range in May 2019. The brand, it is said, is sold via Amazon. Further, during the COVID19 pandemic, the opponent used the 'Ellipsis Labs' brand extensively for handwash and hand sanitiser and sold these products on Amazon and through third-party retailers. In addition, products were sent to various organisations for free, as well as distributed to staff at work and at home. In this connection, Mr Furber says that he feels the opponent has built up considerable goodwill under the name 'Ellipsis Labs' due to the efforts the company went to help local companies during the pandemic, explaining that the opponent donated care boxes (for a value of £150 per box) to local hospitals and schools across East Anglia. In addition, the opponent worked with a charity to donate care packages in hospitals. In this connection, although Mr Furber mentioned 18 hospitals and 2 primary schools, he did not provide any information about how many boxes/packages were distributed and when; further, there is no evidence of whether

the mark ‘Ellipsis Labs’ appeared on products and/or how prominently it was displayed.

51. Mr Furber says that the current ‘Ellipsis Labs’ range includes, but is not limited to, Organic Rosehip Oil, Multivitamin Facial Oil, Squalane, Collagen Serum, Cold-Pressed Marula Oil and Hyaluronic Makeup Primer. This appears to refer to the date when Mr Furber signed his witness statement (16 July 2024), however, it is impossible to know what products were sold under the mark ‘Ellipsis Labs’ prior to the relevant date, i.e. the filing date of the contested application (26 October 2023).

52. As regards marketing spend, Mr Furber says that the opponent’s marketing budget for the ‘Ellipsis Labs’ range is not a set amount but equates to approximately £1,000 per month. Once again, this appears to refer to the date when Mr Furber signed his witness statement (16 July 2024), however, it is impossible to know how much was spent in promoting cosmetic products sold under the brand ‘Ellipsis Labs’ prior to the relevant date of 26 October 2023.

53. In terms of turnover, Mr Furber says that the opponent’s annual sales under the ‘Ellipsis Labs’ brand in the UK are as follows:

2023 - £58,080 - 9,075 units
2022 - £50,175- 7,839 units
2021 -£49,795 - 7,544 units
2020 - £54,101 -- 7826 units

54. The total is around £212,000 over a four-year period; however, it is not clear what proportion of the turnover for 2023 was generated prior to the relevant date.

55. Lastly, Mr Furber says that the opponent has an Ellipsis Brands Linkedln account which has 954 followers and that the Ellipsis Brands are advertised on Amazon, on the opponent’s website, and at trade shows, including the following:

- Nov 2022 Stylist Live

- March 2023 Cosmoprof Worldwide Bologna
- March 2024 Cosmoprof Worldwide Bologna
- May 2024 RAI Exhibition Centre Amsterdam

56. Whilst this evidence is noted, it raises more questions than it answers. First, it is not clear what the Ellipsis Brands are and how prominently the mark 'Ellipsis Labs' is featured in advertisements. It is true that in his second witness statement Mr Furber says that the opponent's brands include 'Lunar Glow', 'Sync Up' and 'Dr Craft', however, that does not assist the opponent because, if anything, it shows that the opponent's marketing efforts include the promotion of unrelated brands. Second, no details of these adverts are given. Third, three of the four trade shows mentioned are outside the UK, and it is not clear whether the "Nov 2022 Stylist Live" was hosted in the UK, and how many people attended the show.

57. As I have already highlighted, there are many gaps in the evidence. Further, the turnover generated prior to the relevant date must be less than £212,000 over a period of 4 years (as the figures for 2023 include sales generated after the relevant date) which, in the context of the cosmetic goods concerned, is very tiny. In this connection, although there is no market share, the cosmetic market in the UK - which include make-up, skincare and haircare products - must be in the region of billions rather than millions.

58. Bearing in mind all of the above, I conclude that the evidence is not sufficient to establish that the distinctiveness of the earlier mark 'Ellipsis Labs' has been enhanced to any material extent.

Likelihood of confusion

59. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier

mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

60. Earlier in this decision I found that:

- The applicant's mark 'ELLIPS' and the opponent's earlier mark 'ELLIPSIS LABS' are visually and aurally similar to a medium to high degree. However, the similar elements 'ELLIPSIS' and 'ELLIPS' are visually and aurally similar to a high degree. Conceptually, whilst there is a conceptual difference between the two words 'ELLIPSIS' and 'ELLIPS', insofar has one has a meaning and the other does not, the word 'ELLIPS' is sufficiently close to the word 'ELLIPSIS' to evoke it - this somewhat counteracts the conceptual difference between the marks.

- The competing goods are either identical or similar to a medium degree.

- The average consumer will select the goods mainly visually, with a medium degree of attention. Although the average consumer includes professional users, where there are two or more classes of average consumers it is the lower level of attention that counts.

- The earlier mark 'Ellipsis Labs' is inherently distinctive to a medium degree. The evidence filed by the opponent does not establish that distinctiveness of the earlier mark has been enhanced to any material extent.

61. Bearing in mind all of the above, I consider that given the high degree of visual and aural similarity between the dominant and distinctive elements 'Ellipsis' and 'ELLIPS' in the competing marks, the allusiveness and/or weakness of the differentiating element 'Labs, and the medium degree of distinctive character of the earlier mark, consumers will directly confuse the applicant's mark with the opponent's earlier mark when encountering it on identical or similar goods. In this connection, the

mere fact that 'Ellipsis' (in the opponent's mark) has a meaning whereas 'ELLIPS' (in the application) has not, does not mean that the marks cannot be confused. The fact remains that the members of the relevant public only rarely have the chance to compare the various marks directly and must therefore rely on their imperfect recollection of them. In the present case, it is my view that the marks are not sufficiently different from a conceptual point of view to be regarded as insufficiently similar from a visual and aural point of view to give rise to a likelihood of confusion. This is all the more so when considering what I said about the applicant's mark evoking the concept conveyed by the earlier mark. Alternatively, there is a risk of indirect confusion, whereby the 'ELLIPS' and 'ELLIPSIS' elements are imperfectly recalled as one another and the inclusion of the word 'LABS' will just be seen as the addition of a descriptive element. Lastly, the applicant's argument about brand loyalty in the cosmetic sector is neither here nor there. Even if this argument is meant to result in a claim that the average consumer will pay a higher-than-normal degree of attention (as it seems it is the case),[3] I reject it. I say this because the public paying a higher-than-normal degree of attention does not mean that it will examine the mark in the smallest detail or that it will compare it in minute detail to another mark. Even with regard to a public with a high (or higher) level of attention, the fact remains that the members of the relevant public only rarely have the chance to compare the various marks directly and must therefore rely on their imperfect recollection of them.[4] Further, in *Bounjourno Cafe* (BL- O/382/10) at paragraphs 12-15 Mr Iain Purvis, sitting as the Appointed Person, rejected the argument that brand loyalty is a factor which could reduce the likelihood of confusion. He stated:

> "I do not accept that a generalized concept of "brand loyalty" is of any real assistance in assessing likelihood of confusion. First of all it is very hard, in my view, to identify particular categories of product or service as inspiring more brand loyalty than others. Secondly, even if were established that there was a high degree of brand loyalty in a particular field, I do not see how this would advance matters. We are concerned with the likelihood of confusion, not the degree of disappointment which would be caused by an incident of confusion. Questions of likelihood of confusion are always to be approached from the point

[3] See paragraph 42 of the applicant's submissions in lieu
[4] See

> of view of the "reasonably observant and circumspect" consumer. I do not understand how brand loyalty can be said to affect the consumer's observation skills or his circumspection. Thirdly, it is rather odd to assume that the concept of "brand loyalty" associated with a general class of products or service tends to reduce the likelihood of confusion, when we are also told by the European Court [*Sabel v Puma* [1998] RPC 199 at 22-24] to assume that a high reputation associated with a specific brand of products or services tends to increase the likelihood of confusion."

62. For the sake of completeness, I should also say that the applicant filed evidence aimed at demonstrating that the opponent does not use the trade mark 'ELLIPSIS' on its website or in relation to cosmetics. This evidence is irrelevant because the earlier mark 'Ellipsis Labs' to which I referred to for the assessment of the likelihood of confusion is less than five years old, and as such, the opponent can rely upon it even if it has not used it (and even if the applicant has used the applied-for mark before the opponent has used the earlier mark). In this connection, the applicant argues as follows:

> *"…the earlier use (and continued use to date) of ELLIPS in relation to hair products, in circumstances in which the Opponent's ELLIPSIS and Ellipsis Labs are not, on any of the evidence submitted, applied to or in use in any relation to cosmetics, renders highly academic and esoteric any argument as to the likelihood of confusion, requiring multiple leaps of conditional thinking: a mark with earlier (and current) use may be confused with a registered mark with an effective date post-dating that other mark's first use, and which registered mark is not yet or not currently in use."*

63. The applicant's argument cannot succeed. The issue of earlier use has no bearing upon the instant proceedings. Tribunal Practice Notice 4/2009 *"Trade mark opposition and invalidation proceedings – defences"*, under the heading "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark"*, outlines the approach. It states:

> "4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.
>
> 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

64. As far as I am aware, at no time did the applicant seek to invalidate the opponent's earlier mark, thus, the existence of a prior right is irrelevant to the issue I have decided.

65. There is a likelihood of confusion. Accordingly, the opposition under Section 5(2)(b) succeeds in its entirety.

Section 5(3)

66. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

67. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

68. In *Spirit Energy Limited* v *Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for Section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in Southeast England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of Section 5(3).

69. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of Section 10(3) – this is the equivalent of Section 5(3) for infringement proceedings. The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

70. Further examples of insufficient reputation are *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited,* [2015] EWHC 256 (Ch) and *Jadebay and Anor v Clarke-Coles Limited* [2017] EWHC 1400 (IPEC).

71. I have already commented on the opponent's evidence above. I do not intend to repeat my assessment of the evidence here but will simply state that in light of the fact that the nature, factors, evidence and assessment of enhanced distinctiveness are the same as for reputation, the outcome is the same. For similar reasons to those I have outlined above, I find that the opponent's evidence does not establish a protectable reputation at the relevant date. The opposition based on Section 5(3) fails accordingly.

Section 5(4)(a)

72. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]
(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

73. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

74. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

75. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
>
> (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.
>
> The question whether deception is likely is one for the court, which will have regard to:
>
> (a) the nature and extent of the reputation relied upon,
> (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
>
> (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
>
> (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
> (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

> In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The relevant date for Section 5(4)(a)

76. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

77. The *prima facie* relevant date is the date the contested mark was filed. Although the applicant has filed evidence of use, it consists of a few undated screenshots showing the applicant's products available for sale on Amazon. As this evidence is undated, the relevant date in these proceedings remains 26 October 2023.

Goodwill

78. The requirement for a finding of goodwill is considerably less onerous than that of reputation and enhanced distinctiveness. However, there are still too many gaps in the evidence as it is not clear from what type of products the turnover has been generated.

In this connection, I remind myself that the turnover figures are not broken down by products and that Mr Furber's statement that *"the current 'Ellipsis Labs' range includes, but is not limited to, Organic Rosehip Oil, Multivitamin Facial Oil, Squalane, Collagen Serum, Cold-Pressed Marula Oil and Hyaluronic Makeup Primer"* means that those products were available for sale at the date when Mr Furber signed his witness statement (16 July 2024) – this, in turn, means that it is impossible to know what products were sold under the mark 'Ellipsis Labs' prior to the relevant date. The most the evidence establishes is that during the COVID19 pandemic (prior to the relevant date), the opponent used the 'Ellipsis Labs' brand for handwash and hand sanitiser. However, these types of goods do not fall within the goods or services in relation to which goodwill is claimed, which are *cosmetic preparations; skincare cosmetics; beauty care cosmetics; moisturisers; serums; face and skin oils; makeup primer; retail services in relation to cosmetics and toiletries; online retail services relating to cosmetics and toiletries; marketing research in the fields of cosmetics, perfumery and beauty products; cosmetic product design and development.* Lastly, even though the opponent relies on various services, the turnover provided by Mr Furber appears to be related to goods as it is measured in units.

79. Accordingly, I conclude that the opponent has failed to establish goodwill in relation to any of the goods and the services claimed.

80. The opposition based on Section 5(4)(a) also fails.

OUTCOME

81. The opposition has been successful under Section 5(2)(b) and the applied for mark will be refused registration.

COSTS

82. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,600 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement: £400
Filing evidence: £700
Submissions in lieu: £300
Official Fees: £200
Total: £1,600

83. I therefore order PT Kino Indonesia Tbk to pay ELLIPSIS BRANDS LIMITED the sum of £1,600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of October 2025

TERESA PINTO
For the Registrar